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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,713	02/28/2002	Jeffrey Scott Weaver	10010089-1	1736

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

RUDOLPH, VINCENT M

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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09/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/085,713

Applicant(s)

WEAVER, JEFFREY SCOTT

Examiner

Vincent M. Rudolph

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Declaration of Prior Invention Under 37 C.F.R. 1.131

The Declaration of Prior Invention filed on 5/22/2007 under 37 CFR 1.131 is sufficient to overcome the Berndt reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 8, 10, 17-18 and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Weller (Pub. # 20020080959).

Regarding claim 1, Weller (Pub. # 20020080959) discloses a method for enabling features of a printing device (printing the document with an authentication mark, See Page 3, Paragraph 0023). This includes requiring authorization of a user before enabling at least one feature of the printing device (determining if it includes predetermined authentication information, See Page 2, Paragraph 0016), receiving information to be printed such that the printing device is enabled to print the information without the one feature of the printing device being enabled (if it does not include the predetermined authentication information, the printer outputs the document as a regular printed document, See Page 2, Paragraph 0018), receiving authorization information of

the user for use of at least one feature of the printing device (the predetermined authentication information is received to be identified by the authenticity verifier prior to outputting the document, See Page 2, Paragraph 0019), so that if the user is authorized to use the feature, enabling information is retrieved for the one feature of the printing device (if the authenticity verifier verifies the predetermined authentication information on the print document, the selected authentication mark is used by the printer, See Page 2, Paragraph 0017), and enabling at least one feature of the printing device so that the information is printed using at least one feature (the selected authentication mark is incorporated into the printed document by the printer to be outputted, See Page 2, Paragraph 0017).

Regarding claim 3, Weller (Pub. # 20020080959) discloses providing a user authorization tag that includes the authorization information of the user (providing a source document signature for verifying the electronic document, See Page 2, Paragraph 0021) so that the authorization information is received when the tag is in a proximity of the printing device (the electronic document is received by the printer over a communication link, See Page 2-3, Paragraph 0022).

Regarding claim 4, Weller (Pub. # 20020080959) discloses determining whether the authorization information of the user is being received (the authenticity verifier within the printer verifies the appended signature, See Page 2-3, Paragraph 002) so that printing is discontinued using at least the one feature if the authorization information of the user is not being received (if the predetermined authorization information is not

confirmed, the printer does not output the document and transmits an error to the user, See Page 3, Paragraph 0024).

Regarding claim 8, Weller (Pub. # 20020080959) discloses that the enabling information for at least one feature is stored by the printing device (stored in the printer memory, See Page 3, Paragraph 0025).

Regarding claim 10, Weller (Pub. # 20020080959) discloses a print system (See Figure 1) with a printing device configured to receive information to be printed (the printer receives an electronic print document to be outputted, See Page 1-2, Paragraph 0014). The print system also has a feature-enabling system communicated with the printing device (authenticity verifier, See Figure 1, Element 36) that requires authorization of a user before enabling at least one feature of the printing device (determining if it includes predetermined authentication information, See Page 2, Paragraph 0016), enable the printing device to print the information without at least one feature of the printing device being enabled (if it does not include the predetermined authentication information, the printer outputs the document as a regular printed document, See Page 2, Paragraph 0018), receive authorization information of the user to use at least one feature of the printing device (the predetermined authentication information is received to be identified by the authenticity verifier prior to outputting the document, See Page 2, Paragraph 0019), if the user is authorized to use at least one feature, retrieve information adapted to enable the feature of the printing device (if the authenticity verifier verifies the predetermined authentication information on the print document, the selected authentication mark is used by the printer, See Page 2,

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Paragraph 0017), and enable at least one feature of the printing device so that the information is printed using at least one feature (the selected authentication mark is incorporated into the printed document by the printer to be outputted, See Page 2, Paragraph 0017).

Regarding claim 17, Weller (Pub. # 20020080959) discloses that at least one feature includes a digital signature (the authentication mark includes a signature, See Page 3, Paragraph 0023, such as a digital signature, See Page 2, Paragraph 0020).

Regarding claims 18 and 21-22, the rationale provided in the rejection of claims 1, 4 and 17 is incorporated herein. In addition, the method of claims 1 and 4 corresponds to the computer readable medium of claims 18 and 21 (additionally Weller (Pub. # 20020080959) discloses a computer readable medium used with a printing device, See Figure 1, Element 39) as well as the print system of claim 17 corresponds to the method of claim 22 and performs the steps disclosed herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller (Pub. # 20020080959) in view of Mazzagatte ('583).

Regarding claim 5, Weller (Pub. # 20020080959) discloses accessing and retrieving the enabling information within the printing device (within the printer memory, See Page 3, Paragraph 0025).

Weller (Pub. # 20020080959) does not disclose accessing and retrieving the enabling information, for at least one feature, from a storage medium outside the printing device.

Mazzagatte ('583) discloses retrieving the enabling information for at least one feature (See Col. 9, Line 25-34). This includes accessing a storage medium to the printing device for obtaining the identification information such as over the internet (See Col. 8, Line 37-40). The information is then retrieved, or downloaded, from the storage medium and adapted to enable the first feature of the printing device, which is submitted with the print job (See Col. 8, Line 40-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include a storage medium, such as the one disclosed by Mazzagatte ('583) and incorporate it into the printing device of Weller (Pub. # 20020080959) because by having an additional storage medium outside the printing device, it is able to be used for backup storage if the internal storage malfunctions or crashes.

Regarding claim 6, Weller (Pub. # 20020080959) does not disclose that the storage medium is a Web site.

Mazzagatte ('583) discloses the storage medium is a web site, which is over the internet, to download the information to the computer (See Col. 8, Line 37-42).

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It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have the storage medium in a Web site, such as the internet as disclosed by Mazzagatte ('583) and incorporate it into the printing device of Weller (Pub. # 20020080959) because the information is able to be downloaded to the computer from the internet and submitted with the print job (See Mazzagatte, Col. 8, Line 40-42).

Regarding claim 7, Weller (Pub. # 20020080959) does not disclose providing the storage medium.

Mazzagatte ('583) discloses the internet provides a storage medium, thus allowing the user to download the information to the computer and submit with the print job (See Col. 8, Line 37-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to provide the storage medium within a Web site, such as the internet as disclosed by Mazzagatte ('583) and incorporate it into the printing device of Weller (Pub. # 20020080959) because the information is able to be downloaded to the computer from the internet and submitted with the print job (See Mazzagatte, Col. 8, Line 40-42).

Regarding claim 19, Weller (Pub. # 20020080959) does not disclose logic to access a Web site and retrieve the information in order to enable at least one feature from a Web site.

Mazzagatte ('583) discloses a logic configured to access a Web site, such as over the internet, and retrieve, or download, the information (See Col. 8, Line 37-42) to enable the first feature from the site (See Col. 9, Line 31-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to access the Web site and retrieve the information to enable at least one feature, such as disclosed by Mazzagatte ('583) and incorporate it into the printing device of Weller (Pub. # 20020080959) because the information is able to be retrieved and downloaded to the computer from the internet and submitted with the print job to enable the feature (See Mazzagatte, Col. 8, Line 40-42).

Claim 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller (Pub. # 20020080959) in view of Bolash ('041).

Regarding claim 9, Weller (Pub. # 20020080959) does not disclose receiving identification information corresponding to a print cartridge of the printing device, determine if it is associated with the printing device, and if not, notifying the user.

Bolash ('041) discloses receiving identification information corresponding to a print cartridge of the printing device and determines whether the identification information corresponding to the print cartridge is associated with the printing device, such as determining if the appropriate type of print cartridge is installed (See Col. 4, Line 32-36). If this information does not correspond to the print cartridge of the printing device, an error message is displayed to notify the user the print cartridge is not associated with the printing device (See Col. 4, Line 43-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have information relating to a print cartridge for a printing device, such as the one disclosed by Bolash ('041) and incorporate it into Weller (Pub. # 20020080959) because whenever a user is authorized to print using the selected printer, if an error, such as incorrectly installing the wrong cartridge, occurred, the user is notified to make the proper changes to be able to print out the document.

Regarding claim 20, the rationale provided in the rejection of claim 9 is incorporated herein. In addition, the method of claim 9 corresponds to the computer readable medium of claim 20 (See Figure 1, Element 39) and performs the steps disclosed.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weller (Pub. # 20020080959) in view of Herbert ('528).

Regarding claim 16, Weller (Pub. # 20020080959) discloses a print system (See Figure 1) with a printing device having a print cartridge, which contains a print substance such as ink to print onto a print medium (an ink jet printer, See Page 2-3, Paragraph 0014).

Weller (Pub. # 20020080959) does not disclose a printing device including an identification reader and a readable identification tag that is in the print cartridge to provide identification information as well as an identification reader to receive the identification information from the identification tag so if it corresponds to the printing device, the reader enables the printing device to print.

Herbert ('505) discloses a printing device for using an identification tag, or a smart device (See Figure 1), on a cartridge (See Figure 2) to communicate with a sensor port (See Figure 1, Element 30) connected to the identification reader, or a microprocessor (See Figure 1, Element 10). The identification reader, or microprocessor, receives the first information, or data, from the identification tag, or the smart device, and if this data corresponds to the correctly and recognized by the microprocessor, it enables the printing device to print (See Col. 4, Line 9-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have the an identification tag on a cartridge disclosed by Herbert ('505) and incorporate it into the print system of Weller (Pub. # 20020080959) because this ensures the print cartridges are correctly associated with the authorized user.

Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller (Pub. # 20020080959) in view of Herbert ('528) as applied to claim 16, and further in view of Mazzagatte ('583).

Regarding claim 11, Weller (Pub. # 20020080959) does not disclose the identification reader includes a receiver to receive authorization information of a user using a wireless communication.

Mazzagatte ('583) discloses a print system having an identification reader that includes a receiver (a smart-card reader, See Figure 1, Element 15), which receives

authorization information of the user using a wireless communication (inserting the smart card into the smart card reader, See Col. 8, Line 30-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have included the wireless receiver, such as the one disclosed by Mazzagatte ('583), and incorporate it into the print system of Weller (Pub. # 20020080959) because it allows a user the ability to not have to enter or submit anything with the electronic document to be authorized and instead use an identification card to verify and authorize the user.

Regarding claim 12, Weller (Pub. # 20020080959) does not disclose receiving the information using a wireless communication.

Mazzagatte ('583) discloses a print system having an identification reader that includes a means for receiving the information using a wireless communication, such as inserting the smart-card into the smart-card reader (See Col. 9, Line 52-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have means for receiving data wirelessly, such as the one disclosed by Mazzagatte ('583), and incorporate it into the print system of Weller (Pub. # 20020080959) because it allows a user the ability to not have to enter or submit anything with the electronic document to be authorized and instead use an identification card to verify and authorize the user.

Regarding claim 13, Weller (Pub. # 20020080959) does not disclose a user authorization tag, which includes memory that relates to the authorization of the user, to communicate with the identification reader via a wireless communication.

Mazzagatte ('583) discloses a print system having a user authorization tag, or a unique identification information contained on a smart-card, used to communicate with the identification reader, such as a smart-card reader (See Col. 9, Line 52-55). When obtained, the user authorization tag has the information stored in a memory located within the smart-card in digital form which is supplied to the computer through the smart-card interface (See Col. 9, Line 46-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have a user authorization tag, such as the one disclosed by Mazzagatte ('583), and incorporate it into the print system of Weller (Pub. # 20020080959) because it allows a user the ability to not have to enter or submit anything with the electronic document to be authorized and instead have the identification information stored on the card verify and authorize the user.

Regarding claim 14, Weller (Pub. # 20020080959) does not disclose having the user authorization tag configured to retrieve the information in order to enable at least one feature of the printing device.

Mazzagatte ('583) discloses a print system with a user authorization tag, or unique identification information, that includes data for the feature-enabling system, or smart-card reader, to retrieve the information (See Col. 9, Line 52-55) and enable the first feature of the printing device (See Col. 9, Line 31-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have a user authorization tag to enable the first feature of the printing device, such as the one disclosed by Mazzagatte ('583), and incorporate it

into the print system of Weller (Pub. # 20020080959) because it allows a user the ability to not have to physically enter or submit anything with the electronic document to authorize the user prior to printing and instead have the identification information stored on the card verify the identity of the user.

Regarding claim 15, Weller (Pub. # 20020080959) does not disclose having the user authorization tag include a uniform resources locator relating to the information in order to enable at least one feature of the printing device.

Mazzagatte ('583) discloses a print system where the user authorization tag, or a unique identification information, includes a uniform resources locator, such as an internet site, corresponding to the information to submit with the print job (See Col. 8, Line 37-42) and enable at least one feature of the printing device (See Col. 9, Line 31-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have included a URL within the user authorization tag, such as the one disclosed by Mazzagatte ('583) and incorporate it into the print system of Weller (Pub. # 20020080959) because a URL, such as a database, is able to store the user information and retrieve the user authorization so it is processed more quickly.

Response to Arguments

Based on the Declaration of Prior Invention under 37 CFR 1.131, it is sufficient to overcome the Berndt reference. Thus, the prior art of Weller is used to meet the claimed limitations as disclosed in the rejection above.

Based on these facts, this action is made **NON-FINAL**.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent M. Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8/29/07
Vmr

Vincent M. Rudolph
Examiner
Art Unit 2625


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8/30/07